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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,860	08/29/2003	John Tomczyk	TAY0013/US	1000
33072 7590 04/17/2007 KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			EXAMINER	
			BRUENJES, CHRISTOPHER P	
			ART UNIT	PAPER NUMBER
			1772	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/652,860	TOMCZYK, JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher P. Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 January 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12,14-39,41-69 and 81-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-12,14-18,27-39,41-46 and 83-88 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19-26,47-69,81 and 82 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070119</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 19, 2007 has been entered.

**WITHDRAWN REJECTIONS**

2. The 35 U.S.C. 112 rejections of claims 25 and 57-64 of record in the Office Action mailed October 17, 2006, Pages 2-3 Paragraph 4, have been withdrawn due to Applicant's amendments in the Paper filed January 19, 2007.

3. The 35 U.S.C. 102 rejections of claims 65-67 and 69 as anticipated by Goggins '196 of record in the Office Action mailed October 17, 2006, Pages 6-9 Paragraph 7, have been withdrawn due to Applicant's amendments in the Paper filed January 19, 2007.

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### **Double Patenting**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 19-26, 47-56 and 65-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 7,153,555.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 19-26, 47-56, and 65-69 are all taught by the claims in Patent '555 except for the following differences, which are all

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obvious changes. First, Patent '555 does not specify that the textured or roughened layer is unitary, however Patent '555 refers to the lenticular lens material as one layer and lenticular lenses are textured. Second, Patent '555 contains an additional transparent layer between the textured layer and the ink layer, but applicant's claims are open and other layers can be present. Although applicant's claims state that the ink layer is bonded to the second surface, bonded does not require that the layers be in direct contact they can be bonded via another layer and still read on the limitation. Third, Patent '555 does not teach that the seam can be a zig-zag seam or sinusoidal seam, but these are obvious shape changes for aesthetic appeal.

6. Claims 19-26, 47-69, and 81-82 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-26, 47-69, and 81-82 of copending Application No. 10/472,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in application '054 are almost identical to applicant's claims except that the claims in application '054 require a lenticular lens layer in place of the

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textured or roughened layer of applicant's claims. However, a lenticular lens is a textured layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 23-24, 51-52, 54-56, and 62-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-24, 51-52, and 65 recite the limitation "the first and second edges". There is insufficient antecedent basis for this limitation in the claim. Note the deletions in the independent claims that defined the first and second edges rendered subsequent claims to lack antecedent basis.

Claims 54-56 recite the limitation "the two ends". There is insufficient antecedent basis for this limitation in the claim. Note the deletions in the independent claims that

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defined the first and second ends rendered subsequent claims to lack antecedent basis.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 19-26, 47-54, and 65-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Guest (US 2002/0114080 A1).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims.

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Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface lenticular lens layer itself does not provide written description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface. See MPEP 2163.

Regarding claims 19, 47, and 65, Guest anticipates a product for displaying images created with textured or roughened material such as lenticular lens material (p.1, paragraph 2 and Figure 2). The product comprises a plastic display surface (reference number 12, Figure 2 and p.3, paragraphs 21-22) and a closed surface textured or roughened insert (reference number 20, Figure 2) in abutting contact with the display surface. The insert includes a unitary textured or roughened layer (reference number 22, Figure 2) having a first surface (the top surface of reference number 22 in Figure 2) and a second surface (the bottom surface of reference number 22 in Figure 2). The insert further comprises first and second ends for contact to one another to form a seam, and first and second edges between the first and second ends (p.5, paragraph 39). An ink layer (reference number 28, Figure 2) is bonded to the second surface of the textured or roughened layer, and a bonding and thermal

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protection substrate (reference number 30, Figure 2) is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface.

Regarding claims 20, 48, and 66, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (p.7, paragraph 51).

Regarding claims 21, 49, and 67, the substrate comprises a material selected from the group consisting of polypropylene, polyester, polyvinyl chloride, polycarbonate, and APET (p.8, paragraph 57) and UV-curable coatings (p.7, paragraph 46).

Regarding claims 22, 50, and 68, the substrate has a thickness in the range of 0.0127 to 0.0762 millimeters, which are 0.5 to 3 mils (p.7, paragraph 50).

Regarding claims 23-24 and 51-52, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert, in which the frame members extend a predetermined retention distance onto the first surface adjacent each of the exposed edges (p.5, paragraph 37 and reference numbers 14, 16, and 18, Figure 3).

Regarding claims 25, 53, and 69, the product is a container and the display surface is an outer wall of the container (Figure 1). Furthermore, regarding claim 25, the textured or

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roughened surface comprises a random set or collection of features forming a lenticular lens. Note random set or collection of features is given its broadest reasonable interpretation, which includes a set that is selected at random.

Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (p.5, paragraph 39).

Regarding claim 54, the two side edges of the insert are beveled and overlap to form a straight seam (p.5, paragraph 39).

11. Claims 19-21, 23, 25-26, 47-49, 51, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/96079 A2).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims.

Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface lenticular lens layer itself does not provide written

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description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface. See MPEP 2163.

Regarding claims 19 and 47, Goggins anticipates a product for displaying images created with textured or roughened material such as lenticular lens material (see abstract). The product comprises a plastic display surface (the molded plastic that fills the mold in Figures 6-8) and a closed surface textured or roughened insert (reference number 10a, Figure 5) in abutting contact with the display surface. The insert includes a textured or roughened layer (reference number 12, Figure 5) having a first surface (the outer surface of reference number 12 in Figure 5) and a second surface (the inner surface of reference number 12 in Figure 5). The insert further comprises first and second ends for contact to one another to form a seam, and first and second edges between the first and second ends (Figs. 12-13, p.13, l.5-9, and p.13, l.15-18). Goggins teaches a seam formed by the first and second opposed ends of the textured or roughened layer because in columns 7 and 8 Goggins teaches that the layer is formed from a flat piece that is shaped to cover a cup and that reference 70 of Figures 12 and 13 represents the shaped textured or roughened layer. Reference 70 is shown in Figures 12 and 13 to be wrapped completely around

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the cup to form a circular cross-section. Therefore, because the layer is formed from a flat piece it must have a seam to form a complete circle. An ink layer (reference number 14, Figure 5) is bonded to the second surface of the textured or roughened layer, and a bonding and thermal protection substrate (reference number 16, Figure 5) is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface.

Regarding claims 20 and 48, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (p.9, l.17-24).

Regarding claims 21 and 49, the substrate comprises a material selected from the group consisting of vinyl plastic or opaque white ink (p.6, l.25 - p.7, l.2). Note an opaque white ink inherently either a solvent based coating or water-based coating since that covers these two groups of coatings includes all types of ink.

Regarding claims 23 and 51, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert since the insert is inserted into the mold during formation and in the embodiment in which the insert forms a portion of the outer surface of the cup

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such as a belly band (p.13, l.7-9) the container would form on both the top edge and bottom edge of the insert.

Regarding claims 25 and 53, the product is a container and the display surface is an outer wall of the container (Figure 10).

Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (Figs. 12-13, p.13, l.5-9, and p.13, l.15-18). Note that the broadest reasonable interpretation of seam does not require that the edges forming the seam be in contact or abutting.

12. Claims 57-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/73497 A2).

The effective filing date of Applicant's invention is the filing date of this application. Applicant's invention does not get the benefit of the dates of the earlier PCT application and provisional applications because the PCT application that this application is a continuation-in-part of does not provide 35 U.S.C. 112 first paragraph support for the claims.

Specifically, the claims of the child application are broader than the disclosure of the parent application and although a lenticular lens layer would inherently have a textured surface

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lenticular lens layer itself does not provide written description for any other types of textured surfaces so therefore does not provide written description for the broad recitation of textured or roughened surface. See MPEP 2163.

Regarding claim 57, Goggins anticipates a product for displaying images created with textured or roughened material (see abstract) comprising a paper display surface (reference number 22, Figure 8, p.12, l.23-25). The product further comprises a closed-surface textured or roughened insert (reference number 30, Figure 6) maintained in position adjacent the paper display surface. The insert includes a textured or roughened layer (reference number 28, Figure 8) having a first surface (the top surface of reference number 28, Figure 8) and a second surface (reference number 28a, Figure 8), and an ink layer (reference number 40, Figure 8) bonded to the second surface of the textured or roughened layer. The first surface of the insert comprises a random collection of features forming a lenticular lens. The insert further comprises a bonding and thermal protection substrate (reference number 42, Figure 8) attached to the ink layer.

Regarding claim 58, the sleeve is maintained in position adjacent the paper surface by an adhesive (reference number 44, Figure 8) between the substrate and the paper display surface.

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Regarding claim 59, the substrate comprises material such as vinyl plastic or opaque, white ink, which is inherently a solvent-based coating or water-based coating since all inks fall into one of those categories.

Regarding claim 61, the product is a container and the display surface is an outer wall of the container (Figure 6 and p.11, l.12-24).

Regarding claim 62, the two side edges of the insert form a straight seam (Figure 6).

13. Claims 19-26, 47-54 and 65-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Raymond et al (USPN 7,153,555).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 19, 47, and 65, Raymond et al anticipate a product for displaying images created with textured or roughened

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material such as lenticular lens material. The product comprises a plastic display surface and a closed surface lenticular lens material in abutting contact with the display surface. The insert includes a unitary lenticular lens layer having a first surface and a second surface. The insert further comprises first and second ends for contact to one another to form a seam, and first and second edges between the first and second ends. An ink layer is bonded to the second surface of the textured or roughened layer, and a bonding and thermal protection substrate is attached to and covering the ink layer. The product further comprises a means for retaining the insert in the abutting contact position on the display surface by bonding to the display surface. (Claim 1, col.18, 1.18-33).

Regarding claims 20, 48, and 66, the retaining means comprises a bonding interface between the substrate and material of the plastic display surface (claim 2, col.18, 1.34-36).

Regarding claims 21, 49, and 67, the substrate comprises a material selected from the group consisting of polypropylene, polyester, polyvinyl chloride, polycarbonate, and APET and UV-curable coatings (claim 3, col.18, 1.37-42).

Regarding claims 22, 50, and 68, the substrate has a thickness in the range of 0.0127 to 0.0762 millimeters, which are 0.5 to 3 mils (claim 4, col.18, 1.43-45).

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Regarding claims 23-24 and 51-52, the retaining means comprises frame members connected to the display surface and abuttingly contacting exposed edges of the insert, in which the frame members extend a predetermined retention distance onto the first surface adjacent each of the exposed edges (claim 7, col.18, l.55-56).

Regarding claims 25, 53, and 69, the product is a container and the display surface is an outer wall of the container (Figure 1).

Regarding claim 26, the insert extends along substantially the entire perimeter of the outer wall such that two side edges of the insert form a seam (col.9, l.40-63).

Regarding claim 54, the two side edges of the insert are beveled and overlap to form a straight seam (col.9, l.40-63).

14. Claims 19-26, 47-69, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by McCannel et al (US 2004/0095648 A1)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any

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invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 19-26, 47-69, and 81-82 of McCannel et al are the same as Applicant's claims 19-26, 47-69, and 81-82 except that McCannel teaches the outside layer is a lenticular lens layer and Applicant claims the outside layer as a textured or roughened layer. However, a lenticular lens layer is a textured layer as shown by reference number 20 in Figure 2 of McCannel. Therefore, because the lenticular lens layer of McCannel is a textured layer and all of the other limitations are taught exactly the same in McCannel, Applicant's claims are anticipated.

#### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 54-56 and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,635,196).

Regarding claims 54-56, Goggins teaches all that is claimed in claim 47 as shown above.

Goggins fails to teach the shape of the seam. However, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that any known shape for the seam would be used to form the seam including a straight seam, sinusoidal seam or zig-zag seam, depending on the intended end result and appearance of the finished article, absent the showing of unexpected result.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select a straight seam, sinusoidal seam, or zig-zag seam for the implicit seam of Goggins depending on the intended end

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result and appearance of the finished article, absent the showing of unexpected result.

Regarding claims 81-82, Goggins teaches an integrally formed closed surface textured or roughened sleeve (reference number 10a) comprises a textured or roughened layer (reference number 12, Figure 2c) comprising a collection of features on an outer face of the layer and an inner face opposed to the collection of features. The sleeve further comprises an outer bonding layer (reference number 20, Figure 2c) having an outer face adjacent the inner face of the textured layer and an ink layer (reference number 14, Figure 2c) having an outer face adjacent the inner face of the outer bonding layer, and the size and features of the textured layer are coordinated with the image layer since the sleeve forms a lenticular lens material. The sleeve further comprises a paper core layer (reference number 22, Figure 2c and col.4, 1.55-60) having an outer face adjacent the inner face of the ink layer and an inner bonding layer having an outer face adjacent the inner face of the paper core for bonding the paper substrate to the molten plastic forming the container.

Goggins fails to teach the sleeve further comprising a clear core layer in the same embodiment as all of the other layers. However, Goggins teaches in an additional embodiment of

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Figure 2b that a clear core layer (reference number 16, Figure 2b) is added to the lenticular lens sleeve of Goggins between the textured layer and image layer in order to provide a special effect or enhance or provide contrast for the image (col.4, 1.25-45). One of ordinary skill in the art would have recognized that Figures 2b and 2c are used as examples to show the many different components that can be added to the sleeve of Goggins and therefore it would have been obvious to combine the components for particular purposes.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add the clear core layer of the embodiment of Figure 2b to the embodiment of Figure 2c, in order to provide a special effect or enhance or provide contrast for the image, as taught by Goggins in the embodiment of Figure 2b.

18. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guest (USPN 6,490,093).

Guest teaches all that is claimed in claim 47 and teaches that the two side edges of the insert form a straight seam having beveled overlapped edges, but fails to teach the seam is sinusoidal or zig-zag. However, Guest teaches that in addition to the straight seam taught in Figure 1, the side edges of the

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insert are formed from a large number of other interweaving shapes and mating techniques to obtain the beneficial features of the container, which is to overcome the weakness inherent in a butt joint between the side edges of the insert including a "zipper" like structure (col.9, 1.59 - col.10, 1.1-6). Therefore, it would have been obvious to one having ordinary skill in the art that any interweaving shape seams would be used to form the seam between the side edges of the insert in order to overcome the weakness of a butt joint, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select a sinusoidal seam or zig-zag seam as the seam in Guest since both seams are interweaving shapes and would therefore overcome the weakness of a butt joint, as taught by Guest, and since the specific shape would be determined by one of ordinary skill depending on the intended end appearance of the finished product, absent the showing of unexpected result.

19. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al (USPN 7,153,555).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only

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under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Guest teaches all that is claimed in claim 47 and teaches that the two side edges of the insert form a straight seam having beveled overlapped edges, but fails to teach the seam is sinusoidal or zig-zag. However, Guest teaches that in addition to the straight seam taught in Figure 1, the side edges of the insert are formed from a large number of other interweaving

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shapes and mating techniques to obtain the beneficial features of the container, which is to overcome the weakness inherent in a butt joint between the side edges of the insert including a "zipper" like structure (col.9, l.40-63). Therefore, it would have been obvious to one having ordinary skill in the art that any interweaving shape seams would be used to form the seam between the side edges of the insert in order to overcome the weakness of a butt joint, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select a sinusoidal seam or zig-zag seam as the seam in Guest since both seams are interweaving shapes and would therefore overcome the weakness of a butt joint, as taught by Guest, and since the specific shape would be determined by one of ordinary skill depending on the intended end appearance of the finished product, absent the showing of unexpected result.

20. Claims 60 and 63-64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,490,092) in view of Guest (USPN 6,490,093).

Regarding claim 60, Goggins teaches all that is claimed in claim 57 but fails to teach the thickness of the substrate layer. However, Guest teaches that substrates of ink or plastic

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on the backside of a lenticular lens sleeve molded to a container has a thickness in the range of 0.5 mils to 3 mils (col.12, 1.24-27 and col.13, 1.25-30) and that the exact thickness is determined based on the intended end result of the article. Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that the thickness of the substrate of a lenticular lens sleeve should be determined by one of ordinary skill in the art based on the intended end result of the article and that a typical range is within 0.5 mils and 3 mils, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select the thickness of the substrate layer of Goggins in the range between 0.5 mils and 3 mils since it is a typical range for a substrate for used for the same purpose as Goggins and since one of ordinary skill in the art would select the thickness desired based on the intended end result of the article, as taught by Guest.

Regarding claims 63-64, Goggins teaches all that is claimed in claim 57 and teaches that the two side edges of the insert form a seam (Figure 6). Goggins fails to teach that the seam is a sinusoidal or zig-zag seam. However, Guest teaches that in addition to a straight seam, interweaving shaped seams and

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mating techniques are used to bring the two side edges of the insert together to form the sleeve around the container, in order to overcome the weakness inherent in a typical butt joint (col.10, l.1-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made that other shaped seams are used in place of straight seam joints in order to form an interweaving connection that is inherently stronger than a typical straight seam, as taught by Guest.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to form the seam of Goggins having an interweaving shape rather than a straight seam in order to form a stronger seam, and that sinusoidal or zig-zag shaped seams would be selected as interweaving shapes depending on the intended end appearance of the finished product, absent the showing of unexpected result.

**Response to Arguments**

21. Applicant's arguments regarding the 35 U.S.C. 112 rejections of record have been considered but they are moot since the rejections have been withdrawn.

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22. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 19-26, 47-54, and 65-69 as anticipated by Guest have been considered but are not persuasive.

In response to Applicant's argument that Guest fails to show the textured or roughened layer as a unitary layer, Guest shows the textured or roughened layer as unitary for two distinct reasons. First, the broadest reasonable interpretation of "unitary" is of, relating to, or involving the use of units or made up of discrete units. See Webster's Dictionary. This definition does not require a layer to be a single layer to be considered "unitary" just that the layer acts as one unitary object, which the combination of layers represented by reference numbers 22 and 24 do. Second, the textured or roughened layer can be considered only to be the actual textured layer, which is represented by reference number 22. Although the claims also have the limitation that the ink layer is bonded to the second surface of the textured or roughened layer, this limitation does not require that the ink layer and textured layer be in direct contact. The broadest reasonable interpretation of "bonded to a surface" includes something that is bonded to that surface via another layer, in Guest that additional layer would be the layer represented by reference number 24.

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23. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 19-21, 23, 25-26, 47-49, 51, and 53 as anticipated by Goggins '196 have been considered but they are not persuasive.

In response to Applicant's argument that Goggins '196 fails to show a bonding and thermal protection layer, Goggins '196 teaches a bonding and thermal protection layer for two distinct reasons. First, applicant's claims do not require a bonding and thermal protection layer they require a bonding and thermal protection substrate. The broadest reasonable interpretation of substrate includes multilayered substrates. Second, Goggins '196 only requires the textured layer and image layer and both the coating layer (reference number 16), which is a thermal protecting layer, and the substrate layer are optional layers. Therefore, Goggins teaches that the coating is applied and an optional substrate layer can be applied but is not required (col.4, l.26-30 and 45-50). Thus, in the embodiment, which is implicit from the description, in which the coating is present but the substrate is not then the coating represents a bonding and thermal protection layer.

24. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 65-67 and 69 as anticipated by Goggins '196

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have been considered but are moot since the rejections have been withdrawn.

25. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 57-59 and 61-62 as anticipated by Goggins '092 have been considered but are not persuasive.

In response to Applicant's argument that Goggins '092 fails to show a bonding and thermal protection layer, this is not agreed for the same reasons applicant's claims teach a bonding and thermal protection layer in the embodiment of claims 57-64. Applicant's claims 57-64 teach a different embodiment of applicant's invention from applicant's other claims. In this embodiment, there is an adhesive layer between the bonding and thermal protection substrate and the paper display surface. This additional adhesive layer not required in Applicant's other claims is required because the insert is being applied to a paper display surface instead of a plastic display surface. Therefore, the layer in Goggins '092 represented by reference 42 is a single layer bonding and thermal protection layer in the same manner as the bonding and thermal protection layer claimed in Applicant's claim 57. The layer of Goggins '092 provides thermal protection to the image layer (reference number 40) and

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it a bonding layer because it is used to bond the insert to the adhesive layer in the same manner as Applicant's claimed layer.

26. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 54-56, 60, and 63-64 of record have been considered but they are not persuasive for the same reasons presented above with regard to the independent claims Applicant has relied on as rendering these claims patentable.

27. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 81-82 of record have been considered but they are not persuasive because claim 81 is an independent claim and not a dependent claim as stated by Applicant and represents a different embodiment from the other independent claims. Applicant presented no other arguments with regard to claims 81-82.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB  
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April 6, 2007

*Alicia Chevalier*  
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PRIMARY EXAMINER